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7590 02/24/2006			EXAMINER	
Richard L. Catania Scully, Scott, Murphy & Presser 400 Garden City Plaza Garden City, NY 11530			NELSON, FREDA ANN	
			ART UNIT	PAPER NUMBER
			3639	
DATE MAILED: 02/24/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/802,248

Applicant(s)

CHEFALAS ET AL.

Examiner

Freda A. Nelson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3-5,10-14,16-19 and 22-36 is/are pending in the application.
- 4a) Of the above claim(s) 12-14 and 16-18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-5,10-11, 19 and 22-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

The communication received on December 27, 2005 is acknowledged and entered.

Claims 2, 6-9, 15, and 20-21 have been canceled. No claims have been added. Claims 12-14 and 16-18 have been withdrawn. Claims 1, 3-5, 10-14, 16-19, and 22-36 are currently pending.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1, 3-5, 10, 19, 22-25, 27-28, 31, and 33-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Flickinger et al. (US PG Pub. 2001/0025245) in view of Thomson et al. (US PG Pub. 2003/0061104).

As for claims 1 and 10, Flickinger et al. discloses a computer-implemented method for automating product registration comprising:

receiving from a seller, and via a communication network, product registration information and associated customer information at a server associated with a manufacturer (Paragraph [0019]) {a method for electronic registration of assets in a registration database, using E-registrar which can be applied for both to online purchases and to conventional purchases};  
wherein:

the product registration information is associated with one or more products that are manufactured by the manufacturer, and purchased by a customer, from the seller (paragraph [0028]; FIG. 3) {an example in which an asset created by a manufacturer (122) is purchased from the seller (120) using a credit card and the third party credit card company (140) provides the asset registration database (130)}; and

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the customer information is associated with the customer and is acquired at a time the customer purchases said one or more products (paragraph [0021]) {the purchaser-specific data file, called an E-registrar, can be an electronic file on a storage media that is accessible to a purchaser's computer (e.g., integrated into the OS or web browser, smart card reader), or could be maintained by a third party (e.g., credit card company website where purchaser creates and updates his E-registrar file via the Internet; and the data on this electronic file can be extracted during the purchasing transaction (e.g., point-of-sale (POS), online) or can be extracted in a separate transaction initiated by the purchaser after the purchasing transaction}.

Flickinger et al. do not disclose said customer information transmitted to the server of said manufacturer to allow the customer to verify and update the product registration information and the customer information. Flickinger et al. do not further disclose completing a product registration of said one or more products when the customer verifies and updates said product registration information and said customer information. Thomson et al. disclose that he electronic warranty administrator then sends the purchaser a welcoming email that includes the warranty administrator's URL (which will enable the customer to access the warranty administrator's home page, as displayed in FIG. 17), plus login instructions and a password which will enable the customer to access their personalized home page (FIG. 3), and the customer is also asked to verify the accuracy of the customer profile in possession of the electronic warranty administrator and to up-date or correct as needed (paragraph 0053). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Flickinger et al. to include the feature of Thomson et al. so a customer can correct information as needed in order to keep their information as accurate as possible.

As for claims 3 and 22, Flickinger et al. disclose the method according to Claim 1, wherein said product registration information comprises a sales transaction record (paragraph [0008]) {a method for automatically registering an asset as part of a purchasing transaction for that asset}.

As for claim 4, Flickinger et al. disclose the method according to Claim 1, wherein the at least one web page is generated when said customer uses a computer to communicate with a website associated with said manufacturer (paragraph [0036]) {an example of how the E-registrar is provided to the vendor manufacturer is by a -drag and drop- E-registrar icon, or alternatively as a file or other unit which can be sent across the network to the manufacturer and the purchaser would send his personal E-registrar via his web browser or email, which would contain standard information needed for registering the asset, to the manufacturer}.

As for claim 5, Flickinger et al. disclose the method according to Claim 1, wherein said customer information includes at least one of a name, address and telephone number of said customer (paragraph [0009])

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{that the electronic file contains data specific to the purchasing entity, including such information as would typically be requested for registration of an asset (e.g., name, address, and marketing information) wherein the data in the E-registrar is extracted by the purchasing transaction application, the credit approval application, or another application activated by one of the parties to the transaction}.

As for claims 19 and 27-28, Flickinger et al. discloses an example in which an asset created by a manufacturer (122) is purchased from the seller (120) using a credit card and the third party credit card company (140) provides the asset registration database (130) (paragraph [0028], FIG. 3); during or at the conclusion of a transaction to purchase an asset, the seller (120) prompts the purchaser (110) to register the asset being purchased (paragraph 0023); the purchaser-specific data file, called an E-registrar, can be an electronic file on a storage media that is accessible to a purchaser's computer (e.g., integrated into the OS or web browser, smart card reader), or could be maintained by a third party (e.g., credit card company website where purchaser creates and updates his E-registrar file via the Internet; and the data on this electronic file can be extracted during the purchasing transaction (e.g., point-of-sale (POS), online) or can be extracted in a separate transaction initiated by the purchaser after the purchasing transaction (paragraph [0021])).

Flickinger et al. do not disclose a computerized system for automating product registration, comprising: a server associated with a seller for: (a) acquiring customer information associated with a customer at a time of purchase of one or more products by said customer, from a seller, (b) associating product registration information with said one or more products, and (c) transmitting via a communication network, and from the seller to a service associated with a manufacturer of said one or more products, said product registration information and said customer information; and the server associated with the manufacturer allows the customer to verify and update said product registration information and said customer information; and the server associated with the manufacturer completes a product registration of said one or more product when the customer verifies and updates said product registration information and said customer information.

Thomson et al. disclose that the electronic warranty administrator then sends the purchaser a welcoming email that includes the warranty administrator's URL (which will enable the customer to access the warranty administrator's home page, as displayed in FIG. 17), plus login instructions and a password which will enable the customer to access their personalized home page (FIG. 3), and the customer is also asked to verify the accuracy of the customer profile in possession of the electronic warranty administrator and to up-date or correct as needed (paragraph [0053]); and the advantages of the invention are the automatic registration of a warranty at the point of sale or through the activation of a cash card magnetically encoded with product information at an Automated Teller Machine (ATM) on the Internet, or by phone, and the ability to acquire point-of-sale information via the Internet (paragraph [0017]). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Flickinger et al. to include the feature of

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Thomson et al. so a customer can correct information as needed in order to keep their information as accurate as possible.

As for claim 23 and 34, Flickinger et al. disclose the system according to claim 19, wherein said server associated with the seller utilizes a telephone number provide by said customer at said time of purchase to retrieve said customer information from a directory (paragraph [0009]; [0021]) {the electronic file contains data specific to the purchasing entity, including such information as would typically be requested for registration of an asset (e.g., name, address, and marketing information; the purchaser-specific data file, called an E-registrar, can be an electronic file on a storage media that is accessible to a purchaser's computer (e.g., integrated into the OS or web browser, smart card reader), or could be maintained by a third party (e.g., credit card company website where purchaser creates and updates his E-registrar file via the Internet; and the data on this electronic file can be extracted during the purchasing transaction (e.g., point-of-sale (POS), online) or can be extracted in a separate transaction initiated by the purchaser after the purchasing transaction}.

Flickinger does not disclose that utilizing a telephone number to retrieve customer information, however, it is old and well known in the business art that telephone numbers are used to retrieve customer information. It is old and well known that grocery stores and department stores use customer telephone numbers in lieu of smart cards to retrieve customer information in order to give customers discounts. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Flickinger to include the feature telephone number feature as another means to retrieve customer information.

As for claims 24 and 35, Flickinger et al. disclose the system according to claim 19, wherein the seller manually enters said customer information at said time of purchase (paragraph [0005]) {in the case of some assets which are purchased at a retail outlet or on-line, the purchaser is asked to register the asset on-line via an Internet connection and in either case, the user must perform the product or warranty registration manually (i.e., fill out the card by hand and mail it or log onto the Internet and enter the requested information)}.

As for claim 25, Flickinger et al. disclose the system according to claim 19, wherein the server associated with the manufacturer allows the customer to verify said product registration information and said customer information by generating at least one web page when said customer uses a computer to communicate with a website associate with said manufacturer (paragraph [0036]) {the purchaser would send his personal E-registrar via his web browser or email, which would contain standard information needed for registering the asset, to the manufacturer wherein the manufacturer would extract the pertinent information from the E-Registrar and register the product, and the registration process would be accomplished; and the manufacture would provide verification of registration and other information (e.g. warranties) either on

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the spot through the browser or email, or subsequently through other means, such as mail or facsimile}.

As for claims 31 and 33, Flickinger et al. disclose a program storage device readable by a machine, tangibly embodying a program of instructions, executable by said machine to perform a method for automating product registration, the method comprising:

(a) acquiring customer information associated with a customer at a time of purchase of one or more products by said customer, from a seller (paragraph [0021]) {the purchaser-specific data file, called an E-registrar, can be an electronic file on a storage media that is accessible to a purchaser's computer (e.g., integrated into the OS or web browser, smart card reader), or could be maintained by a third party (e.g., credit card company website where purchaser creates and updates his E-registrar file via the Internet; and the data on this electronic file can be extracted during the purchasing transaction (e.g., point-of-sale (POS), online) or can be extracted in a separate transaction initiated by the purchaser after the purchasing transaction};

(b) associating product registration information with said one or more products; and

(c) transmitting, via a communication network, and from the seller to a server associated with a manufacturer of said one or more products, said product registration information and said customer information (paragraph [0021]) {the purchaser-specific data file, called an E-registrar, can be an electronic file on a storage media that is accessible to a purchaser's computer (e.g., integrated into the OS or web browser, smart card reader), or could be maintained by a third party (e.g., credit card company website where purchaser creates and updates his E-registrar file via the Internet; and the data on this electronic file can be extracted during the purchasing transaction (e.g., point-of-sale (POS), online) or can be extracted in a separate transaction initiated by the purchaser after the purchasing transaction}.

the server associated with the manufacturer generates at least one web page using said product registration information and said customer information transmitted thereto to allow the customer to verify and update said product registration information and said customer information; and

the server associated with the manufacturer completes a product registration of said one or more products when the customer verifies and updates said product registration information and said customer information.

Flickinger et al. does not disclose said customer information transmitted to the server of said manufacturer to allow the customer to verify and update the product registration information and the customer information. Flickinger et al. does not further disclose completing a product registration of said one or more products when the customer verifies and updates said product registration information and said customer information. Thomson et al. disclose that he electronic warranty administrator then sends the purchaser a welcoming email that includes the warranty administrator's URL (which will enable the customer to access the warranty administrator's home page, as

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displayed in FIG. 17), plus login instructions and a password which will enable the customer to access their personalized home page (FIG. 3), and the customer is also asked to verify the accuracy of the customer profile in possession of the electronic warranty administrator and to up-date or correct as needed (paragraph [0053]). Thomson et al. still further disclose that still further advantages of the invention are the automatic registration of a warranty at the point of sale or through the activation of a cash card magnetically encoded with product information at an Automated Teller Machine (ATM), on the Internet, or by phone, and the ability to acquire point-of-sale information via the Internet (paragraph [0017]). Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Flickinger et al. to include the feature of Thomson et al. so a customer can correct information as needed in order to keep their information as accurate as possible.

As for claim 36, Flickinger et al. disclose the method of claim 1 wherein said updating includes registering said one or more products for the customer or for a new donee (paragraph [0038]) {the re-seller would provide the service of registering the purchased item with the manufacturer for and on behalf of the purchaser}.

2. Claims 11, 29-30 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Flickinger et al. (US PG Pub. 2001/0025245) in view of Thomson et al. (US PG Pub. 2003/0061104), still in further view of Dovolis (US PG Pub. 2001/0034609).

As for claims 11, 29-30, and 32, Flickinger et al. do not disclose that the at least one web page allows said customer to indicate that the at least one product is a gift to a donee, said update including customer information relating to said donee.

Dovolis discloses a simple and effective method for registering warranty information at the point of purchase (paragraph [0013]); the system monitors the duration of the warranty period for each product so that a consumer may later visit the site to see when their warranty expires, to transfer warranties from one person to another if the product is given as a gift, and to view product instructions and other information available online for that particular product (paragraph [0013]); and the system provides a means for consumers to view their purchases on a consumer web page and to personalize their consumer page so as to categorize their products in any way that makes sense to them (paragraph [0013]). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Flickinger et al. to include the feature of Dovolis in order to allow warranties to be transferred to from one person to another as is done with automobiles and homes.



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3. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Flickinger et al. in view of Thomson et al. (US PG Pub. 2003/0061104), still in further view of Byrd et al. (Patent Number 6,069,941).

As for claim 26, Flickinger et al. does not disclose that the server associated with the manufacturer comprises a voice response unit server. Byrd et al. disclose that as part of the prompt to the subscriber 12, the active one of the VRUs 24 and 25 or the PC server 26 also provides an option to allow the subscriber to register the product (col. 6, lines 25-27); and the information entered by the subscriber 12 in connection with product registration is typically stored in a transcription VRU 46 within the call platform 20 having the capability of recording the subscriber-entered registration information; and the registration information stored in the transcription VRU 46 may be accessed by a customer transcriber 50 (i.e., a computer maintained by the product manufacturer) that communicates with the call platform 20 by calling a pre-assigned POTS routed to the switch 16 (col.6, lines 35-46). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Flickinger et al. to include the feature of Byrd et al. in order to allow consumers to an use alternative option to contact the manufacturer's server.

### ***Response to Amendment and Arguments***

Applicant's arguments filed November 10, 2005 have been fully considered but they are not persuasive.

In response to the applicant's argument that Flicking does not teach or suggest a computer-implemented method for automating product registration including generating at least one web page using the product registration information and the customer information transmitted to the server of the manufacturer to allow the customer to verify and update the product registration information and the customer information, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208

USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "the entire purchase and registration occurs in one transaction") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to applicant's argument that there is no suggestion to combine the references of Flickinger et al. and Thomson, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, both references teach the convenience of electronic product registration and/or warranties which is the particular problem with which the applicant is concerned.

In response to applicant's argument that there is no suggestion to combine the references of Flickinger et al. and Thomson, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation

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to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Byrd teaches a subscriber software registration (product registration) which is the applicant's field of endeavor.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

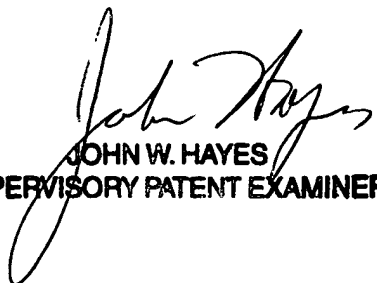
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Freda A. Nelson whose telephone number is (571) 272-7076. The examiner can normally be reached on Monday - Friday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on 571-272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

FAN 02/08/2006



**JOHN W. HAYES**  
**SUPERVISORY PATENT EXAMINER**